

1 The opinion in support of the decision being entered today is *not* binding
precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GINA SPARACINO

Appeal 2007-2069
Application 10/723,000
Technology Center 3600

Decided: October 31, 2007

Before TEDDY S. GRON, CAROL A. SPIEGEL, and MARK NAGUMO,
Administrative Patent Judges.

GRON, *Administrative Patent Judge.*

DECISION ON APPEAL

Introduction

This is an appeal under 35 U.S.C. § 134 from an Examiner's final rejection, under 35 U.S.C. § 103, of Claims 1-18 of Application 10/723,000, filed November 26, 2003. Claims 1, 2, 5, 6, 8-13, 16, and 18 stand finally rejected under 35 U.S.C. § 103(a) in view of Seal et al. (Seal), U.S. Patent

5,347,797, patented September 20, 1994 (Supplemental Examiner's Answer, entered May 16, 2006, page 3 (Ans. 3)). Claims 3, 4, 7, 14, and 15 stand finally rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Seal and Willson, U.S. Patent 4,608,812, patented September 2, 1986 (Ans. 3). Claim 17 stands finally rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Seal and Solatinow, U.S. Patent 918,212, patented April 13, 1909 (Ans. 3). We AFFIRM.

Independent Claims 1, 8, and 18, reproduced below, are representative of the claimed subject matter.

1. Auxiliary saddle stirrup for facilitating mounting of a horse having a saddle secured thereon, comprising:
 - a strap having an upper end and a lower end, the upper end being attachable to the saddle at a location rearwardly remote from a primary stirrup on the saddle;
 - a foot loop on the lower end of the strap so as to be positioned behind and below the primary stirrup when the strap hangs down from the saddle.
8. A saddle comprising:
 - a seat;
 - a primary stirrup hanging downwardly from the seat; and
 - an auxiliary stirrup hanging downwardly from the seat behind and below the primary stirrup.
18. A method for a rider to mount a horse having a saddle secured thereto, comprising:
 - placing the rider's right foot into a first stirrup hanging from the saddle; then
 - stepping up on the first stirrup; then
 - placing the rider's left foot into a second stirrup hanging from the saddle, the first stirrup being behind and below the second stirrup, and without crossing the rider's legs; then
 - stepping up on the second stirrup,
 - removing the right foot from the first stirrup; and then

swinging the rider's right leg over the horse so that the rider is seated in the saddle.

Appellant has not argued the patentability of any of the dependent claims separately from the independent claims. Rather, Appellant argues that one limitation critical to the invention defined by independent Claims 1, 8, and 18 patentably distinguishes the subject matter defined by its claims from the subject matter described by Seal (Corrected Brief On Appeal, dated April 12, 2006 (Br. 3-10)). That one limitation defines the auxiliary stirrup as hanging downwardly from the seat of the saddle at a location below and "behind . . . the primary stirrup" (Br. App'x Claims 1 and 8) so that the rider's left foot may be placed into the primary riding stirrup when the right foot is in the auxiliary mounting stirrup without crossing legs (Br. App'x Claim 18). At minimum then, we conclude that every dependent claim on appeal stands or falls with the claim upon which it depends. Accordingly, we need consider only the patentability of Claims 1, 8, and 18 under 35 U.S.C. § 103(a) in view of Seal's disclosure. 37 CFR § 41.37 (c)(1)(vii).

Discussion

1. Claim interpretation

"In proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification." *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). In that light we conclude first that the "auxiliary saddle stirrup" of Claim 1 comprises "a strap having an upper end and a lower end" with the upper end being attachable to the saddle and the lower end of the strap having a foot loop. The phrases "being attachable to the saddle" and "so as

to be positioned behind and below the primary stirrup when the strap hangs down from the saddle” are mere expressions of intended use. Accordingly, the language directed to the position of an attachable auxiliary saddle stirrup relative to the position of the primary stirrup of a saddle to which the auxiliary saddle stirrup may or may not be attached does not necessarily further limit the “auxiliary saddle stirrup” of claim 1.

2. Claim 1 would have been obvious in view of Seal

Seal describes an auxiliary saddle stirrup comprising a strap having an upper end and a lower end. The upper end of the strap is attachable “on any saddle having a horn, stirrup bar or any other device by which . . . [the claimed mounting stirrup assembly] may be attached to the saddle thereby providing the equestrian with a safe convenient method of mounting said saddle” (Seal, col. 3, ll. 31-35). The lower end of the strap is attached to the foot loop of a normal riding stirrup (Seal, Figs. 1, 3, and 6-8; Claims 1-4). We find that Seal describes every element of the subject matter defined by Appellant’s Claim 1. We have already concluded that the positioning language that Appellant argues patentably distinguishes the claimed auxiliary saddle mounting stirrup from the mounting saddle stirrup assembly described by Seal does not further limit the full scope of the “attachable” auxiliary saddle stirrup defined by Appellant’s Claim 1. Accordingly, we find that the subject matter of Claim 1 would have been obvious in view of Seal's disclosure, anticipation being the epitome of obviousness.

3. Claims 8 and 18 would have been obvious in view of Seal

Claim 8 is directed to a saddle comprising a seat having both primary and auxiliary stirrups attached to the seat, the auxiliary stirrup “hanging downwardly from the seat behind and below the primary stirrup” (Br. App’x

Claim 8). Claim 18 is drawn to a method for a rider to mount a horse having a saddle defined by Claim 8 secured thereto. From Appellant's characterization of the Seal saddle (Specification 1:25–26; 2:20–21) and the claimed saddle, it is evident that "behind" means "further from the horse's head."

Seal appears to depict a Western saddle having the auxiliary stirrup ahead of the primary stirrup (Figs. 1 and 2). Seal also expressly describes and depicts an English saddle having the auxiliary stirrup even with the primary stirrup (Figs. 3 and 6–8). In Seal's words, "When the loop 2 is passed over the stirrup bar 7, the stirrup bar already has straps from the saddle's regular stirrups attached to it. Therefore, the loop 2 has to be sufficiently large to allow the loop 2 to fit over the stirrup bar when the regular stirrup straps are already attached" (Seal, col. 2, ll. 34–39). In both cases, the auxiliary stirrup hangs below the primary stirrup.

As to Claim 8, the issue is whether attaching the auxiliary stirrup to the saddle at a position so as to hang behind and below the primary stirrup of the saddle would have been obvious to a person having ordinary skill in the art. To establish the obviousness of the claimed subject matter, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

"Section 103 forbids issuance of a patent when the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which [the] subject matter pertains." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). "If a person of ordinary skill in the

art can implement a predictable variation, and would likely see the benefits of doing so, § 103 likely bars its patentability.” *Id.* at 1740, 82 USPQ2d at 1396. In *KSR*, the Supreme Court rejected a rigid application of the teaching, suggestion, or motivation test in an obviousness inquiry. *Id.* at 1739, 82 USPQ2d at 1395. The Court noted the importance of identifying “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” to avoid hindsight reconstruction of the claimed invention. *Id.* at 1731, 82 USPQ2d at 1396. The Court emphasized, “[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *KSR Int’l Co.*, 127 S.Ct. at 1740, 82 USPQ2d at 1395.

In this case, Appellant claims a structure described and depicted by Seal that has been altered to reposition the auxiliary mounting stirrup behind the primary or normal riding stirrup of the saddle. The record indicates that saddles are relatively simple mechanical devices that have numerous points of attachment for auxiliary equipment, such as the pommel of the Western saddle, the stirrup strap 7, or the D-ring 9, which Seal describes as “normally a part of any English riding saddle” (Seal, col. 3, ll. 7–8). Thus adding additional points of attachment appears to have been within the level of ordinary skill in the art. Hence, we have no trouble finding that Seal’s teaching that the auxiliary mounting stirrup may be used “on any saddle having . . . any other device by which the invention may be attached to the saddle thereby providing the equestrian with a safe convenient method of mounting said saddle” (Seal, col. 3, ll. 31–35), would have taught persons

having ordinary skill in the art that the upper end of any strap holding Seal's auxiliary mounting stirrup may be attached to a Western or English Saddle at any position on the saddle relative to the primary or normal riding stirrup which attachment position is consistent with safe mounting. Therefore, in the absence of a showing of unexpected results, the invention Appellant claims would have been obvious to a person having ordinary skill in the art.

Appellant appears to argue that the elimination of whatever leg-crossing problems might be associated with Seal's invention is a result sufficiently unpredictable to warrant the patentability of the claimed invention over the invention Seal describes and suggests. We think not. As the Supreme Court explained, "[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill." *KSR* at 1734, 82 USPQ2d at 1391.

Appellant urges that the Examiner's silence as to the evidence (frames taken from a CD video submitted after the final rejection¹) requires reversal (Reply Brief filed 9 September 2005, at 2.) This argument lacks merit. Even accepting Appellant's characterizations of what the frames show, the crossing of the legs required when mounting the prior art assembly and the absence of crossing of the legs when mounting the claimed invention result from the relative positions of the auxiliary stirrups to the primary stirrups. The weight of the evidence of record indicates that the different relative positions of the auxiliary stirrup to the primary stirrup and the benefits derived therefrom would have been predictable to persons having ordinary

¹ Appellant appears to suggest that the Examiner did not view the CD video.

skill in the art. Seal's preference for convenience in attaching the strap of the auxiliary stirrup to the saddle (Seal, col. 3, ll. 29-35) does not diminish the obviousness of nonpreferred, inconvenient embodiments. *In re Burckel*, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976). We find that the evidence supporting nonobviousness is outweighed by the evidence supporting obviousness.

According, we conclude that the subject matter defined by Appellant's Claims 1, 8, and 18 would have been obvious to a person having ordinary skill in the art at the time made and is, therefore, unpatentable under 35 U.S.C. § 103(a) over Seal. Since all dependent claims stand or fall with Appellant's Claims 1, 8, and 18, we affirm the Examiner's final rejections of Claims 1-18 of Application 10/723,000, filed November 26, 2003, under 35 U.S.C. § 103(a).

Conclusion

Having considered all the evidence and arguments of record for and against the patentability of Claims 1-18 of Application 10/723,000 under 35 U.S.C. § 103(a), we affirm all the appealed final rejections.

Order

Upon consideration of the appeal, and for the reasons given, it is

ORDERED that the decision of the Examiner rejecting Claims 1-18 of Application 10/723,000 under 35 U.S.C. § 103(a) is affirmed; and

FURTHER ORDERED that the time for taking future action in this appeal cannot be extended under 37 CFR § 1.136(a)(2006).

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AFFIRMED

VW

cc: Via (U.S. MAIL)

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